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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,090	06/21/2002	Stephen Arkinstall	220316USOPCT	7121
22850	7590	11/24/2006	EXAMINER	
C. IRVIN MCCLELLAND OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			CHANG, CELIA C	
			ART UNIT	PAPER NUMBER
			1625	

DATE MAILED: 11/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/088,090

Filing Date: June 21, 2002

Appellant(s): ARKINSTALL ET AL.

**MAILED**

**NOV 24 2006**

**GROUP 1600**

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Daniel J. Pereira  
For Appellant

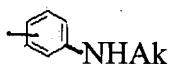
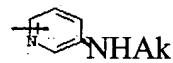
**SUPPLEMENTAL EXAMINER'S ANSWER**

This is in response to the appeal brief filed Aug. 29, 2006 appealing from the Office action  
mailed Jun 29, 2006.

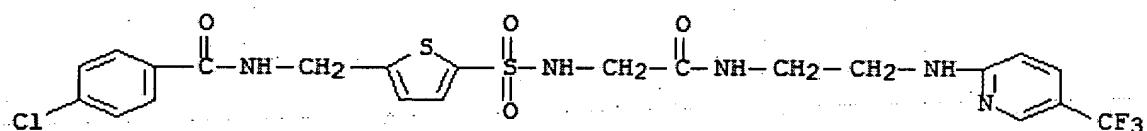
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**The New Matter Rejection under 35 USC 112 1<sup>st</sup> paragraph**

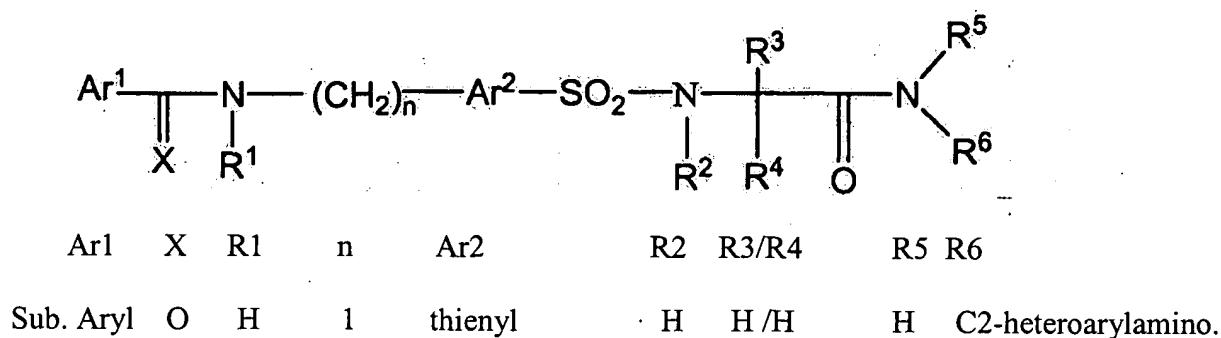
Appellants argued that page 11, lines 10-25 provided literal support and recited the paragraphs on page 2 of the supplemental brief. The structure of such substituted R6 is hereby illustrated, R6 is alkyl substituted by e.g.

<u>Definition</u>	<u>structure</u>
C1-C6 alkylaminoaryl--	
C1-C6-alkylamino heteroaryl--	
Cyclic C4-C8alkyl-- containing 1-3 heteroatom.....	
Unsubstituted or substituted aryl-- or heteroayl--	 

Compound of claim 9 is,



which is when compounds of claim 1 :



Therefore, the instant claim 1 limiting to R3 and R4 both being hydrogen in combination with the rest of the scope of claim 1 is clearly new matter for which no compound being drawn to R6 is C1-C6 alkylaminoaryl , C1-C6-alkylamino heteroaryl, Cyclic C4-C8alkyl containing 1-3 heteroatom....., unsubstitued or substituted aryl or heteroayl, can be found because all the compounds have R6 being heteroarylaminoalkyl which was not found on page 11.

#### **The objection under 37 CFR 1.75c**

The comparison of structural delineation in the new matter section will be self evidence for the impropriety of dependency since claim 9 does not read on the base claims.

#### **The Obviousness Rejection in view of US '149**

A detailed structural comparison of the exemplified compounds of US '149 with comparison to the instant claims have been made in the Examiner's Answer (see p.10 Ex. Answer). Appellants' argument that the US '149 requires polyamine groups does not obviate the obviousness in the established *prima facie* case suggested by the reference. An investigation of the compounds of claim 9 for which one of the compound was displayed in the new matter section, it will be self evident that whether appellants called the compounds polyamine or not, the exemplified compound contain multiple amines, thus, chemically are polyamines.

#### **The rejection under 35 USC 112 1<sup>st</sup> paragraph**

It has been clearly made of record that the analysis of the enablement issue under 35 USC 112 1<sup>st</sup> paragraph during prosecution and in the brief, has been made based on *factual evidence*. The reliance of Appellants of *two single species*, explicitly excluded by the generic description;

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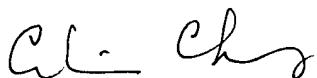
*in a screening test* which is *devoid* of any information as to its indication of up or down

regulation; is *factual evidence* for deficiency of enablement supporting the claimed scope.

Whether Appellants relied or withdrawn the arguments with respect to the data collected in the specification does not obviate the deficiency.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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Art Unit 1625

Conferee



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